

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Kieran MURPHY
APPLICATION NO. : 10/727,667
TITLE : DEVICE VIEWABLE UNDER AN IMAGING BEAM
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EXAMINER : BUI, VY Q.
GROUP ART UNIT : 3773
ATTORNEY DOCKET NO. : 8131-41
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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejection of May 29, 2009 in the above-identified application (the "Office Action"). This request is being filed with a Notice of Appeal, and no amendments are being filed. Claims 1-23 are pending in the application. Claims 2-3, 5-9 and 17-23 have been withdrawn from further consideration. Claims 1 and 19 are independent.

Claim Rejections

Claims 1, 4 and 11-16 have been rejected as being unpatentable over U.S. Patent No. 5609629 (Fearnott, et al., hereinafter "Fearnott").

Issues

Applicant's request for review centres on two issues. First, the Examiner has failed to clearly specify the grounds on which the subject claims are being rejected. Second, the Examiner has failed to meet the legal requirements

required to support either an anticipation rejection or an obviousness rejection, as the cited art clearly lacks at least one element of claim 1 and no articulated reasoning has been provided.

Detailed Arguments

The Examiner has rejected claims 1, 4 and 11-16 "under 35 U.S.C. 102(b) as anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fearnott et al." The MPEP, at section 706.02, reads in part as follows:

"By far the most frequent ground of rejection is on the ground of unpatentability in view of the prior art, that is, that the claimed subject matter is either not novel under 35 U.S.C. 102, or else it is obvious under 35 U.S.C. 103. The language to be used in rejecting claims should be unequivocal." [emphasis added]

By rejecting the subject claims on the grounds of both anticipation and obviousness, the Examiner has not clearly specified which legal test is being applied to the claims.

In any event, Applicant submits that the Examiner has not satisfied the requirements for a rejection based on either one of anticipation and obviousness. The Examiner simply asserts, at page 2 of the Office Action, that Fearnott discloses a stainless steel stent, "including coatings of soluble polymers and a radiologic opacifier material such as iodine-containing compound."

Applicant notes, in the event that the Examiner intended to reject the claims under 35 U.S.C. 102, that in order to support a finding of anticipation the Examiner must show that Fearnott teaches every element of the claims. Section 2131 of MPEP reads, in part, as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)"

Applicant submits that the Examiner has failed to make such a showing, and that an anticipation rejection would therefore be improper. In particular, as argued at page 5 of Applicant's Reply dated February 27, 2009, Fearnott fails to satisfy at least the following element of claim 1:

"a density enhancing radiologic opacifier embedded into said polymer"

Fearnott describes a device with a "structure 12 composed of a base material 14" (col. 6, ll. 51). In addition, Fearnott provides "at least one layer of a bioactive material positioned over the structure" (col. 7, ll. 30-32), as well as "at least one porous layer 20 positioned over the layer 18 of bioactive material" (col. 9, ll. 27-29). As noted by the Examiner, the bioactive material can be an iodine-containing compound. However, Fearnott makes no mention whatsoever of "a density enhancing radiologic opacifier material embedded into said polymer." Indeed, Fearnott does not provide any material embedded into any other material. Rather, the various materials of Fearnott are clearly disposed in discrete layers, as evidenced in the above-cited portions of Fearnott, as well as Fearnott's Figure 1.

Claim 1 therefore cannot possibly be anticipated by Fearnott, and is patentable for at least the above reasons.

Applicant further notes, in the event that the Examiner intended to reject the claims under 35 U.S.C. 103, that in order to support a finding of obviousness the Examiner must show that the cited art teaches or suggests each and every limitation of the rejected claim:

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) [emphasis added]. Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974))."

Ex Parte Wada and Murphy, Appeal No. 2007-3733, Bd. Pat. App. & Inter., January 14, 2008. the Examiner must also provide "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (MPEP 2141, *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S., 82 USPQ2d 1385 (2007)). Because at least one limitation of claim 1 is not satisfied by Fearnott and because the Examiner has failed to provide the requisite reasoning, an obviousness rejection would be improper.

Specifically, as discussed above Fearnott does not satisfy at least the element of, "a density enhancing radiologic opacifier embedded into said polymer," recited in Applicant's claim 1. The Examiner has provided no indication of where in Fearnott such an element is provided. The Examiner has also not asserted any other teaching of the element, or provided any other reasoning as to how a person skilled in the art would come to apply the element to Fearnott. Applicant further submits that by explicitly teaching that separate materials are to be placed in separate layers, Fearnott would in fact lead a person skilled in the art directly away from such an element, even if the element were to be found

elsewhere in the prior art. Additionally, at column 9, lines 53-59, Fearnot states the following:

"It is for this reason that the bioactive material lies under the at least one porous layer 20, rather than being dispersed within or throughout it."
[emphasis added]

Fearnot thus explicitly discourages any material embedded within another material. Claim 1 therefore cannot be obvious in view of Fearnot, and is patentable for at least the above reasons.

As claim 1 is patentable, all remaining claims currently under consideration are also patentable in that they depend on claim 1. In view of the above arguments, reconsideration and allowance of the subject application are respectfully requested.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0679.

Respectfully submitted,

/Frank Chau/

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Date